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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,387	07/12/2001	Mark James Yunker	0197FV.45384-US	1616

7590 10/09/2002

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EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/904,387

Applicant(s)

YUNKER ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period of Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## **DETAILED ACTION**

### ***Drawings***

Figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the one or more respective notches" in lines 7-8.

There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "its periphery" in line 7. Whose periphery does this refer to? That of the guide or that of the chute?

Claim 2 recites the limitation "the respective sides" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the direction of product movement" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the direction" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the bottom" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the respective notches" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the alignment" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the respective tabs" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the alignment" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the respective tabs" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites "whereby the product guide moves upwardly from the bottom of the chute with oversize products moving along the chute and being restored into position by the tabs moving downwardly into the respective notches."

This recitation is functional. This recitation is narrative in form. It confuses a reader in that it seems to indicate that the guide moves upwardly as oversized products move upwardly. It is also clear that the guide of the instant application does not move upwardly *from the bottom* of the chute, because it never contacts the bottom nor does it rest immediately adjacent to it at any point during operation.

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It is also clear from the invention that the sole means by which the guide is restored into position is not *by the guides* moving downwardly. The guides assist, but do not restore the guide into position to the extent that it can be said that the restoration is "by the tabs moving downwardly".

Claims 3 and 4 recite "to allow the product guide to move upwardly from the bottom of the chute". This recitation suffers the same indefiniteness as the recitation cited above from claim 1.

Claims 5 and 6 are similarly deficient, although the relationships are expressed slightly differently from claim 1. Please revise these claims as well.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 11, and 12 rejected under 35 U.S.C. 102(b) as being anticipated by US 4,700,827 to Haaser.

The embodiment of figures 5, 10, and 11 are pertinent to this rejection. Specifically, figure 5 discloses the more than two sides of a chute with a bottom, support brackets, each bracket having a notch for receiving tabs of a product guide which moves upwardly "from the bottom" of the chute.

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The recitation of the preamble "for a gravity slide sorter" is considered by the office to be intended use. The "chute" of the reference is intended to line articles up and dispense them in an aligned, one-at-a-time fashion. It is a vibratory slide, thus would become a "gravity slide" if it were at all inclined. Vibratory slide feeders are commonly inclined a few degrees to assist in moving the items thereon.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. There are no structural elements of claim 1 which distinguish it over the reference, as the reference clearly teaches a chute through which items slide.

Applicant has not positively recited a sorter, only a slide.

The reference further teaches a pin to allow upward movement, and the guide is dimensionally elongated in a direction of product movement.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Many references were retrieved which deal with the inventive concept. Please review these references prior to response, as removal of subject matter from the claims could yield new rejections.

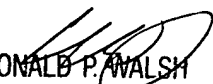
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks  
September 27, 2002

  
DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600